

ESTTA Tracking number: **ESTTA259323**

Filing date: **01/07/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	KIPP FOUNDATION
Granted to Date of previous extension	01/07/2009
Address	345 SPEAR ST., SUITE 510 San Francisco, CA 94105 UNITED STATES
Attorney information	Eugene Pak DLA Piper US LLP 555 Mission Street, Suite 2400 San Francisco, CA 94105 UNITED STATES ttabdoCKET@dlapiper.com,eugene.pak@dlapiper.com Phone:415-836-2500

Applicant Information

Application No	77331129	Publication date	09/09/2008
Opposition Filing Date	01/07/2009	Opposition Period Ends	01/07/2009
Applicant	Phillipson, Shannon #1 5110 Alderfield Place West Vancouver, V7W2W7 CANADA		

Goods/Services Affected by Opposition


Class 009. All goods and services in the class are opposed, namely: Video Tapes, Video Cassettes, Pre-recorded Compact Discs and Pre-recorded Digital Video Discs featuring educational programs in the Field of Street Smarts, Personal Safety and Life Skills for Children and Young Adults; and Decorative Magnets; Cellular Phones and Cellular Phone Cases
Class 014. All goods and services in the class are opposed, namely: Jewelry, Imitation Jewelry and Costume Jewelry and Parts Thereof, Namely, Decorative Chain, Ornamental Pins, Bracelets and Charms


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2873379	Application Date	11/29/2002
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Registration Date	08/17/2004	Foreign Priority Date	NONE
Word Mark	KIPP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1994/08/00 First Use In Commerce: 1994/08/00 Printed instructional, educational, and teaching materials, namely, books and lesson plans for educationally underserved students and school teachers in the upper elementary and middle school levels, all of the above provided and used within the public school system on a non-profit basis		


U.S. Registration No.	2796977	Application Date	08/13/2002
Registration Date	12/23/2003	Foreign Priority Date	NONE
Word Mark	KIPP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1998/08/00 First Use In Commerce: 1998/08/00 Charitable fundraising services; providing educational scholarships to educationally underserved students in the upper elementary and middle school levels within the public school system Class 041. First use: First Use: 1998/08/00 First Use In Commerce: 1998/08/00 Educational counseling, counseling on the selection of schools, providing information about schools, and offering guidance about the high school and college application and matriculation process for educationally underserved students in the upper elementary and middle school levels within the public school system, all of the above provided on a non-profit basis		


U.S. Registration	2888254	Application Date	08/01/2002
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No.			
Registration Date	09/28/2004	Foreign Priority Date	NONE
Word Mark	KIPP		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 1994/08/00 First Use In Commerce: 1994/08/00 Arranging and conducting classes, seminars, conferences and workshops in the field of education and life development of educationally underserved students in the upper elementary and middle school levels within the public school system, and distributing course materials in connection therewith; identifying, recruiting and training educational leaders to operate and teach in public schools serving educationally underserved students in the upper elementary and middle school levels; developing educational materials and curriculum in the field of upper elementary and middle school education for educationally underserved students within the public school system; analyzing educational tests scores and data of educationally underserved students within the public school system; providing courses of instruction for educationally underserved students at the upper elementary and middle school levels within the public school system, and distributing course materials in connection therewith; all of the above provided on a non-profit basis</p>		


U.S. Registration No.	2876207	Application Date	11/29/2002
Registration Date	08/24/2004	Foreign Priority Date	NONE
Word Mark	KIPP:		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 2001/07/00 First Use In Commerce: 2001/07/00 Printed instructional, educational, and teaching materials, namely, books and</p>		

	lesson plans for educationally underserved students and school teachers in the upper elementary and middle school levels, all of the above provided and used within the public school system on a non-profit basis
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U.S. Registration No.	2818928	Application Date	08/13/2002
Registration Date	03/02/2004	Foreign Priority Date	NONE
Word Mark	KIPP:		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 2001/07/00 First Use In Commerce: 2001/07/00 Charitable fund raising services; providing educational scholarships to educationally underserved students in the upper elementary and middle school levels within the public school system</p> <p>Class 041. First use: First Use: 2001/07/00 First Use In Commerce: 2001/07/00 Educational counseling, counseling on the selection of schools, providing information about schools, and offering guidance about the high school and college application and matriculation process for educationally underserved students in the upper elementary and middle school levels within the public school system, all of the above provided on a non-profit basis</p>		

U.S. Registration No.	2824508	Application Date	08/01/2002
Registration Date	03/23/2004	Foreign Priority Date	NONE
Word Mark	KIPP:		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2001/07/00 First Use In Commerce: 2001/07/00		

	Arranging and conducting classes, seminars, conferences, and workshops in the school curriculum for educationally underserved students in the upper elementary and middle school levels within the public school system, and distributing course materials in connection therewith; training educational leaders to operate and teach in public schools serving educationally underserved students in the upper elementary and middle school levels; developing educational materials and curriculum in the field of upper elementary and middle school education for educationally underserved students within the public school system; analyzing educational tests scores and data of educationally underserved students within the public school system; providing courses of instruction for educationally underserved students at the upper elementary and middle school levels within the public school system, and distributing course materials in connection therewith; all of the above provided on a non-profit basis
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U.S. Registration No.	2347241	Application Date	07/12/1999
Registration Date	05/02/2000	Foreign Priority Date	NONE
Word Mark	KIPP ACADEMY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1995/00/00 First Use In Commerce: 1995/00/00 educational services, namely providing courses of instruction at the primary level		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	KIPP		
Goods/Services	apparel, CDs, DVDs, other goods		

Attachments	76470629#TMSN.gif (1 page)(bytes) 76439694#TMSN.gif (1 page)(bytes) 76436628#TMSN.gif (1 page)(bytes) 76470647#TMSN.gif (1 page)(bytes) 76439640#TMSN.gif (1 page)(bytes) 76436627#TMSN.gif (1 page)(bytes) 75748399#TMSN.jpeg (1 page)(bytes) Notice of Opposition re KIP.pdf (6 pages)(157635 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Eugene Pak/
Name	Eugene Pak

Date	01/07/2009
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

KIPP FOUNDATION

Opposer,

v.

SHANNON PHILLIPSON

Applicant.

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) **OPPOSITION No. _____**
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) **NOTICE OF OPPOSITION**
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Trademark: KIP

Serial No.: 77331129

Int'l Class: 9 and 14

As grounds for Opposition, KIPP Foundation ("KIPP") alleges as follows.

1. Opposer KIPP Foundation is a non-profit public benefit corporation organized and existing under the laws of the State of California, having a place of business at 345 Spear Street, Suite 510, San Francisco, California 94105 (hereafter "KIPP").

2. KIPP believes that it will be damaged by registration of the trademark KIP (hereafter the "KIP Mark") for the goods identified in Application Serial No. 77331129 (the "Application"), in classes 9 and 14, filed by Shannon Phillipson (hereafter "Applicant").¹ The Application was filed on November 16, 2007, under Section 1(b) of the Lanham Act, and alleges a bona fide intent to use the KIP Mark in connection with "video tapes, video cassettes, pre-recorded compact discs and pre-recorded digital video discs featuring educational programs in the field of street smarts, personal safety and life skills for children and young adults; and decorative magnets; cellular phones and cellular phone cases" in International Class 9 and

“jewelry, imitation jewelry and costume jewelry and parts thereof, namely, decorative chain, ornamental pins, bracelets and charms” in International Class 14.

3. KIPP is a national network of open-enrollment, college-preparatory public schools with a track record of preparing students in underserved communities for success in college and in life. There are currently 66 KIPP schools in 19 states and the District of Columbia serving over 16,000 students. Since 1995, KIPP and KIPP schools have been using the mark KIPP, including in stylized form, in connection with a variety of goods and educational services, and have received extensive favorable media coverage. KIPP has developed common law rights in the KIPP mark and also owns several federal trademark registrations for the mark (collectively, the “KIPP Mark”), including those listed below:

Mark	Reg. No.	Goods/Services
KIPP	2,873,379	Class 16: printed instructional, educational, and teaching materials, namely, books and lesson plans for educationally underserved students and school teachers in the upper elementary and middle school levels, all of the above provided and used within the public school system on a non-profit basis
KIPP	2,796,977	Class 36: Charitable fundraising services; providing educational scholarships to educationally underserved students in the upper elementary and middle school levels within the public school system. Class 41: Educational counseling, counseling on the selection of schools, providing information about schools, and offering guidance about the high school and college application and matriculation process for educationally underserved students in the upper elementary and middle school levels within the public school system, all of the above provided on a non-profit basis
KIPP	2888,254	Class 41: Arranging and conducting classes, seminars, conferences and workshops in the field of education and life development of educationally underserved students in the

¹ KIPP notes that it timely filed a request for extension of time to oppose the Application which was granted to January 7, 2009.

		upper elementary and middle school levels within the public school system, and distributing course materials in connection therewith; identifying, recruiting and training educational leaders to operate and teach in public schools serving educationally underserved students in the upper elementary and middle school levels; developing educational materials and curriculum in the field of upper elementary and middle school education for educationally underserved students within the public school system; analyzing educational tests scores and data of educationally underserved students within the public school system; providing courses of instruction for educationally underserved students at the upper elementary and middle school levels within the public school system, and distributing course materials in connection therewith; all of the above provided on a non-profit basis
KIPP:	2,876,207	Class 16: Printed instructional, educational, and teaching materials, namely, books and lesson plans for educationally underserved students and school teachers in the upper elementary and middle school levels, all of the above provided and used within the public school system on a non-profit basis
KIPP:	2,818,928	Class 36: Charitable fund raising services; providing educational scholarships to educationally underserved students in the upper elementary and middle school levels within the public school system. Class 41: Educational counseling, counseling on the selection of schools, providing information about schools, and offering guidance about the high school and college application and matriculation process for educationally underserved students in the upper elementary and middle school levels within the public school system, all of the above provided on a non-profit basis.
KIPP:	2,824,508	Class 41: Arranging and conducting classes, seminars, conferences, and workshops in the school curriculum for educationally underserved students in the upper elementary and middle school levels within the public school system, and distributing course materials in connection therewith; training educational leaders to operate and teach in public schools serving educationally underserved students in the upper elementary and middle school levels; developing educational materials and curriculum in the field of upper elementary and middle school education for educationally underserved students within the public school system; analyzing educational tests scores and data of educationally underserved students within the public school system; providing courses of

		instruction for educationally underserved students at the upper elementary and middle school levels within the public school system, and distributing course materials in connection therewith; all of the above provided on a non-profit basis
KIPP ACADEMY	2,347,241	Class 41: Educational services, namely providing courses of instruction at the primary level

4. The KIPP Mark is a strong and distinctive mark. Applicant's KIP Mark is confusingly similar to KIPP's KIPP Mark as it closely resembles KIPP's KIPP Mark in sound and appearance, and is to be applied to goods which are education-related and which are also directed to children and young adults. The proposed use of the KIP Mark is likely to cause confusion and misunderstanding as to origin, sponsorship, affiliation or endorsement by or with KIPP, in violation of KIPP's rights in its mark under 15 U.S.C. §§ 1114 and 1125.

5. If Applicant were granted registration in the KIP Mark, confusion resulting in damage and/or other injury to KIPP would be caused and would result by reason of the similarity between the KIP Mark and KIPP's KIPP Mark and the goods. Consumers familiar with KIPP Mark may purchase or use Applicant's products bearing or using the KIP Mark in the mistaken belief that such products are sold, sponsored or endorsed by KIPP, or otherwise affiliated with KIPP. Furthermore, any faults or objections found with Applicant's products or would reflect poorly upon and injure the reputation that KIPP has established for its goods or services.

Wherefore, KIPP prays that this Opposition be sustained and that registration of the KIP Mark covered by Application Serial No. 77331129 be denied.

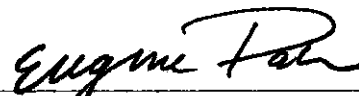
Please charge the statutory filing fee of \$600.00 (\$300 per class) and any additional fees that may be required to the DLA Piper US LLP Deposit Account No. 19-4215 (Our Attorney Reference No. 549603-900104)

Respectfully submitted,

KIPP FOUNDATION

Dated: January 7, 2009

By:


Eugene M. Pak
DLA Piper US LLP
153 Townsend Street, Suite 800
San Francisco, CA 94107
ttabdocket@dlapiper.com

Counsel for KIPP Foundation

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document:

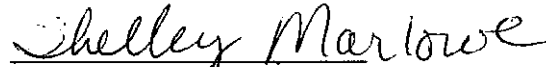
NOTICE OF OPPOSITION

was served on Applicant Shannon Phillipson, by depositing the same in the United States mail,

First Class Mail, postage prepaid, addressed to Applicant's counsel of record as follows:

Patchen M. Haggerty
Dorsey & Whitney LLP
1420 Fifth Avenue, Suite 3400
Seattle, Wa 98101-4010

this 7th day of January 2009.


Shelley Marlowe